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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,918

07/15/2003

John W. Sadler

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8948

7590

08/25/2004

AGILENT TECHNOLOGIES, INC.

Legal Department, DL429

Intellectual Property Administration

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EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,918

Applicant(s)

SADLER ET AL.

Examiner

Daniel St.Cyr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-21 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawal Of The Allowable Subject Matter

1. The indicated allowability of claims 1 and 3-21 is withdrawn in view of the newly discovered reference(s) to Perry US Patent No. 5,511,052. Rejections based on the newly cited reference(s) follow.

Specification

2. The specification of the disclosure is objected to because the continuation application information on page 1 should include the Patent numbers. Correction is required.

Claim Objections

3. Claim 11 is objected to because of the following informalities: line 1, "11" should be changed to --10--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims do not add any additional limitations to the parent claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Maxell, JP patent No. 08063750.

Maxell discloses an optical disk drive device comprising: a laser actuation circuit 5 for generating a light beam and capable of delivering the beam to a surface array of chemicals; a detector 6 for detecting a response of the surface to the light beam; reciprocating the light beam and the surface with respect to one another at a relative speed; and compensating for variable integral illumination per detected data sample of the response (see the abstract).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 2-7, 10, 13, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry, US Patent No. 5,511,052, in view of Yamaguchi et al, US Patent No. 5,146,440.

Perry discloses a digital compensator for controlling a servo to correct the value of a given parameter of a system comprising: a laser 10 for generating a light beam and delivering the beam to a surface 18; a detector 30/32 for detecting a response of the surface of the light beam; a mover for reciprocating the light beam and a motor 22 for reciprocating the surface with respect to one another at a relative speed; and modulating a sample period based on the relative speed (see figure 1; col. 3, line 29+ and col. 6, line 40 to col. 7, line 13), wherein the reciprocating takes place under a focused light beam (see figure 1, item 28). With regard to the specific relative speed, such limitation fall within the engineering design choice for performing a specific task. Therefore, it would have been obvious, wherein the specific array type, such as biochemical, DNA chip, etc., is specific method of used, and, therefore, obvious.

Perry fails to disclose or fairly suggests using voice coil for reciprocating the light beam and the surface with respect to one another.

Yamaguchi et al disclose a track search apparatus comprising: an objective or focusing lens 1 and a reflecting mirror 2, mounted on a transfer table 3, are adapted to be driven by a voice coil motor 4 substantially in the radius direction of a disk 6 which is being rotated by a disk motor 5. A light beam emitted from a light source 7 such as a semiconductor diode passes through a collimator lens 8 which serves to convert the light beam into a parallel light (see figure 1 and col. 3, line 31+).

In view of Yamaguchi et al's teachings, it would have been obvious for an artisan at the time the invention was to employ the well known voice coil motor as a driving means in lieu of the mover and disk motor for reciprocating the light beam and the surface with respect to each other. Such modification would make the system more effective by providing continuous

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uniform power output to drive the system components. Furthermore, such modification would be more convenient by employ already established components in the art to provide optimal compatibility. Therefore, it would have been an obvious extension as taught by Perry.

Allowable Subject Matter

11. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
Art Unit 2876

